

Remarks

Reconsideration of this Application is respectfully requested.

Claims 14 and 16 are pending in the application. Claims 3, 9, 11-13, 15 and 17 were previously cancelled without prejudice to or disclaimer of the subject matter therein. Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

Rejections under 35 U.S.C. §§ 102 and 103

Claims 14 and 16 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by or in the alternative under 35 U.S.C. § 103(a) as allegedly obvious over Asrar *et al.* (USPN 7,098,170). Applicants traverse this rejection.

The current claims are directed to a method of protecting soya bean plants subject to attack by phytopathogenic fungi against soya bean rust, consisting essentially of applying fluquinconazole to the seed of said plants to protect said plants from subsequent attack by phytopathogenic fungi. In contrast, as discussed in detail in Applicants' Amendment and Reply of October 16, 2008, and of March 10, 2009, Asrar *et al.* does not disclose soy bean rust, or even the *Phakospora* fungal species known to cause soybean rust. Moreover, Asrar *et al.* does not disclose protecting soy bean plants susceptible to subsequent attack by phytopathogenic fungi. Rather, the disclosure of Asrar *et al.* is directed to a "method of increasing the vigor and/or the yield of an agronomic plant comprising treating the plant or its propagation material with an effective amount of an active agent which has the capability of increasing the yield and/or vigor of the plant *in the absence of pest pressure by fungal plant pathogens*, where the active agent is

selected from the group consisting of a diazole fungicide, a triazole fungicide, and a strobilurin-type fungicide." Asrar *et al.*, col. 2, lines 44-51 (emphasis added).

It is settled law that for process/method claims, "the 'material acted upon' must be given weight." *See Ex parte Zbornik and Peterson*, 109 U.S.P.Q. 508, 509 (BPAI 1956) ("Zbornik"). The Examiner continues to ignore this law in maintaining the rejections of the pending claims. For the Examiner's benefit, an explanation of the law is provided.

In *Zbornik*, the rejected claims are related to a process of treating Air Sac Infection in fowl. The representative claim 26 read:

A process of treating Air Sac Infection in fowl which comprises introducing into the intestinal tract of the bird infected with the causative agent of said disease a poultry feed containing approximately 0.1% of a compound selected from the group consisting of para-aminobenzoic acid, water-soluble salts of para-aminobenzoic acid and mixtures thereof, and maintaining said treatment for a period of not less than five days.

Id. at 508.

The reference (Marshall) cited by the Examiner disclosed a sulfonamide therapy of malaria in ducks and includes a control run (a comparative test) with a drug diet of 0.1% para-aminobenzoic acid for 18 hours prior to artificial inoculation and six days thereafter. The Examiner held that Marshall substantially met the claims because: "Marshall shows introducing into the intestinal tract of a bird a poultry feed containing approximately 0.1% of a compound selected from the group consisting of para-aminobenzoic acid, water-soluble salts of para-aminobenzoic acid and mixtures thereof and maintaining said treatment for a period of not less than five days." *Id.* The Patent Office Board of Appeals disagreed and stated that "[w]e find ***no merit*** in this rejection because in holding that Marshall substantially meets the claims *the examiner is obviously giving no weight to the limitation in the claims that the medicated feed is*

administered to fowls infected with Air Sac Infection. He thus *fails to follow the long line of decisions* in which it was held that *in evaluating the patentability of process claims the 'material acted upon' must be given weight.*" *Id.* at 509 (emphasis added). The Board pointed out that "Marshall was not concerned with appellants' problem and he failed to even remotely suggest its solution." *Id.* at 508.

Similarly in the case at bar, in rendering the rejection, the Examiner failed to give weight to the "material acted upon," *i.e.*, soya bean plants subject to subsequent attack by phytopathogenic fungi. Asrar *et al.* does not disclose protecting plants subject to subsequent attack by phytopathogenic fungi. Rather, Asrar *et al.* focuses solely on increasing the yield and/or vigor of plants *in the absence of pest pressure by fungal plant pathogens.* Thus, the material acted upon in Asrar *et al.* is not the same that that of the current claims and the Examiner has failed to give weight to this difference. As such, the Examiner's position on which the rejection is based, *i.e.*, that "Asrar et al. disclose all the limitations of the instant claims where soybean and seed are treated with fluquinconazole alone and/or combined with azoxystrobin which inherently protects the soybean from soybean rust" is improper in light of the holding of *Zbornik*. Thus, Asrar et al does not anticipate the present claims.

The Examiner then asserts that "[i]f one argues that the claimed method is not taught, it would be obvious to one of ordinary skill in the art to assume that a method of increasing the vigor and/or yield of a soybean plant . . . would protect said soybean from rust." Office Action at 4.

The Examiner's rejection under 35 U.S.C. § 103(a) is based on the belief that the claimed method is inherently present in Asrar *et al.* Office Action at 4. However,

obviousness cannot be based on unknown properties of a composition. *See In re Ehrreich*, 590 F.2d 902, 909 (C.C.P.A. 1979) ("The question in a § 103 case is what the references would collectively suggest to one of ordinary skill in the art."); *see also In re Spormann*, 363 F.2d 444, 448 (C.C.P.A. 1966). "That which may be inherent is not necessarily known . . . [and] [o]bviousness cannot be predicated on what is unknown." *In re Spormann*, 363 F.2d at 448; *see also In re Adams*, 356 F.2d 998 (C.C.P.A. 1974).

Applicants assert that the Examiner's analysis is flawed, because the claimed method was not known taught by Asrar *et al.* and there is nothing in the Asrar *et al.* disclosure that would have led one of ordinary skill in the art to practice the currently claimed methods. Not only does Asrar *et al.* not disclose soy bean rust or even the fungal pathogen that causes it, but Asrar *et al.* focuses solely on increasing the yield and/or vigor of plants *in the absence of pest pressure by fungal plant pathogens*. The assertion that one could have arrived at the presently claimed method from the unknown allegedly inherent features of Asrar *et al.* is flawed because Applicants method is not disclosed in Asrar *et al.* and obviousness of the claimed subject matter cannot be predicated on an unknown or allegedly inherent property of the art. *In re Ehrreich*, 590 F.2d at 909; *In re Spormann*, 363 F.2d at 448; *see also In re Adams*, 356 F.2d 998. Thus, a *prima facie* case of obviousness has not been established.

In sum, Asrar *et al.* does not anticipate claims 14 and 16, and the Examiner has not established a *prima facie* case of obviousness of claims 14 and 16. Reconsideration and withdrawal of the rejections are earnestly solicited.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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Date: Sept 16, 2010

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